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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,151	10/14/2005	Isao Kinoyama	Q90856	8994
65565	7590	11/14/2008		
SUGHRUE-265550				
2100 PENNSYLVANIA AVE. NW				
WASHINGTON, DC 20037-3213				
EXAMINER				
MURRAY, JEFFREY H				
ART UNIT		PAPER NUMBER		
1624				
MAIL DATE		DELIVERY MODE		
11/14/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/553,151

Applicant(s)

KINOYAMA ET AL.

Examiner

JEFFREY H. MURRAY

Art Unit

1624

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 and 4-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2 is/are rejected.
- 7) ☒ Claim(s) 4-6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Status of Claims

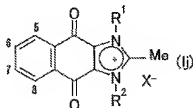
1. Claims 2 and 4-6 are pending in this application. Claims 1 and 3 have been cancelled. This action is in response to the applicants' amendment after a non-final action and reply filed on July 14, 2008.

Withdrawn Rejections/Objections:

2. Applicant is notified that any outstanding rejection/objection that is not expressly maintained in this office action has been withdrawn or rendered moot in view of applicant's amendments and/or remarks.

Claim Objections and Claim Rejections - 35 USC § 102

3. Claim 2 remains rejected under 35 U.S.C. 102(b) as being anticipated by Matsuhisa, et. al., WO2001060803. Table 24 of the prior art shows the following:



Co	R ¹	R ²	X	Co	R ¹	R ²	X
75	-CH ₂ (Pyr)	-(CH ₂) ₂ OMe	Br	81	-CH ₂ (Pyr)	-(CH ₂) ₂ CO ₂ ⁻	-
76	-CH ₂ (Py3)	-(CH ₂) ₂ OMe	Br	82	-CH ₂ (Py4)	-(CH ₂) ₂ CO ₂ ⁻	-
77	-CH ₂ (Py4)	-(CH ₂) ₂ OMe	AcO	83	-CH ₂ (Py3)	-CH ₂ CO ₂ ⁻	-
78	-CH ₂ (Pyr)	-(CH ₂) ₂ OMe	AcO	84	-(CH ₂) ₂ OMe	-CH ₂ CO ₂ ⁻	-
79	-CH ₂ (Py3)	-(CH ₂) ₂ OMe	PhSO ₃	85	-CH ₂ (Py4)	-(CH ₂) ₂ OMe	I
80	-(CH ₂) ₂ OMe	-(CH ₂) ₂ OMe	PhSO ₃	86	-(CH ₂) ₂ OMe	-(CH ₂) ₂ OMe	I

The specification defines Pyr as 2-pyrazinyl. It can clearly be seen that compound #75 is the same as the compound described in Claim 1. The applicants

have argued that both the claim objection and the 102(b) rejection should be removed because the prior art claims do not contain all of the claim limitations of the present application. However, when one looks at the claim limitations, one skilled in the art would see that the "limitations" are merely a recitation of the physical data of the compound or composition. Physical solid state properties of a compound are just that, properties. An X-Ray diffraction pattern or a differential scanning calorimeter (DSC) analysis are considered "physical properties" of a crystal and thus are inherent features of the crystal. According to M.P.E.P. 2112:

**I. SOMETHING WHICH IS OLD DOES NOT
BECOME PATENTABLE UPON THE DIS-
COVERY OF A NEW PROPERTY**

"[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). >In *In re Crish*, 393 F.3d 1253, 1258, 73 USPQ2d 1364, 1368 (Fed. Cir. 2004), the court held that the claimed promoter sequence obtained by sequencing a prior art plasmid that was not previously sequenced was anticipated by the prior art plasmid which necessarily possessed the same DNA sequence as the claimed oligonucleotides. The court stated that "just as the discovery of properties of a known material does not make it novel, the identification and characterization of a prior art material also does not make it novel." *Id.*< See also MPEP § 2112.01 with regard to inherency and product-by-process claims and MPEP § 2141.02 with regard to inherency and rejections under 35 U.S.C. 103.

Applicants are correct that the Matsuhisa, et. al. document does not discuss these properties. However, this does not mean it is a new or novel property. It is simply a property that was not discussed or demonstrated. These terms are physical properties and therefore are considered inherent properties.

Here a compound was synthesized in the prior art as compound #75. The prior art is silent as to its X-Ray diffraction pattern or DSC analysis but as these properties being inherent cannot make the old compound "patentably new." Claim 2 is rejected on this basis and claims 4-6 are objected to be as being substantial duplicates of claim 2. In addition, Claim 2 has two periods at the end of the claim, one must be deleted. Applicants arguments are not found persuasive. The rejection is maintained.

Conclusion

4. Claim 2 are rejected.
5. Claims 4-6 are objected.
6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey H. Murray whose telephone number is 571-272-9023. The examiner can normally be reached on Mon.-Thurs. 7:30-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisors, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey H Murray/
Examiner, Art Unit 1624

**/James O. Wilson/
Supervisory Patent Examiner, Art Unit 1624**